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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,449	06/01/2006	Peter Huntemann	291257US0PCT	2170
22850	7590	02/20/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER KASHNIKOW, ERIK				
ART UNIT 1794		PAPER NUMBER		
NOTIFICATION DATE 02/20/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/581,449

Applicant(s)

HUNTEMANN ET AL.

Examiner

ERIK KASHNIKOV

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm et al. (6,387,447) in view of Croft (US 5,688,860).
3. Grimm et al. teach coatings for offshore pipes (column 2 lines 5-10).
4. In regards to claims 11 and 13 Grimm et al. teach that the coating for the pipes comprises polyurethane formed from an isocyanate compound, hollow microbeads, as well as a polyol (OH number 36) and castor oil component (example 1).
5. In regards to claim 12 Grimm et al. teach the addition of diethylene glycol to the mixture for forming the polyurethane (example 1).
6. In regards to claim 15 Grimm et al. teach a coating thickness of 45mm for the polyurethane layer (column 4 line 25).
7. In regards to claim 16 Grimm et al. teach the process for forming the offshore pipe (column 3 line 31 to column 4 line 32).
8. While Grimm et al. teach the pipe and the process for making the pipe as discussed above they are silent regarding Applicant's desired concentrations and viscosity.

9. Croft teaches polymeric elastomers which can be used as encapsulants, sealants and end seals for various objects (column 1 lines 9-11).
10. Croft teaches that the polymeric elastomers can be a polyurethane (column 2 lines 36-37). Croft teaches that the polyurethane can be formed from a mixture that includes a polyisocyanate, castor oil, a polyol as well as hollow microspheres (example 9). Croft teaches that the castor oil be present at concentrations of 52.9 percent by weight and the polyol at concentrations of 47.1% by weight, which are within applicant's ranges.
11. In regards to claim 14 absent a showing of criticality with respect to "viscosity" (a result effective variable), it would have been obvious to a person of ordinary skill in the art at the time of the invention to adjust the "viscosity" through routine experimentation to values, including those presently claimed, in order to achieve "an optimal viscosity of the reactive mixture which allows for effective coating of the pipe". It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).
12. One of ordinary skill in the art at the time of the invention would be motivated to modify the coated pipes of Grimm et al. with the polymer of Croft, because the pipe of Grimm et al. which are able to withstand pressures of 50 bar and temperatures above 120°C would benefit from the varying viscoelastic characteristics, which allow for a wide range of uses (column 2 lines 30-34) of the polymer of Croft.

Response to Arguments

13. Applicant's arguments, see arguments, filed 10/02/08 and 11/06/08, with respect to the objection of the claims have been fully considered and are persuasive. The objection of the claims has been withdrawn.

14. In regards to applicant's arguments regarding the improvement in hydrolytic stability it is noted that "obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation", *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1966). As the concentration of the castor oil is present in the references within applicants ranges and proper motivation was given to combine the references the rejection still stands. Given that there is proper motivation to combine the references and given that the combination discloses pipe as presently claimed, it is clear that the pipe would therefore also intrinsically possess hydrolytic stability as does the pipe of the present invention. With respect to unexpected results, Examiner points out that the affidavit compares the instant invention against an embodiment wherein the polyol concentration is 2.5pbw, which is not commensurate in scope with the closest prior art. Examiner further points out that as set forth in MPEP 716.02(d), whether unexpected results are the results of unexpectedly improved results or a property not taught by the prior art, "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support". In other words, the showing of unexpected results must be reviewed to see if the results occurred over the entire claimed range, *In re Clemens*, 622F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA

1980). It is further pointed out that the data is not persuasive given that there is not proper side-by-side comparison between the inventive example and the comparative example given that the examples use different amounts and types of polyol and different amount of dipropylene glycol and therefore it is not clear if the differences in hydrolytic stability are due to the castor oil or to the polyols. It is further pointed out that in regards to a declaration showing unexpected results regarding a property the courts have upheld that a "basic property or utility must be disclosed in order for affidavit evidence of unexpected properties to be offered," *In re Davies et al.*, 177 USPQ 381 (CCPA 1973).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIK KASHNIKOW whose telephone number is

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(571)270-3475. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Erik Kashnikov
Examiner
Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794